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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/117,838 08/12/98 EPHSTEIN

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HM22/1020

EXAMINER

OWENS JR, H

ART UNIT

PAPER NUMBER

1623

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DATE MAILED:

10/20/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/117,838

Applicant(s)  
Ephstein

Examiner  
Howard Owens

Group Art Unit  
1623



☐ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 5-8 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 5-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*Howard C. Lee*

Howard C. Lee  
Primary Examiner  
Art Unit 1623

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Response to Arguments***

The following is in response to the amendment filed 3/22/99:  
An action on the merits of claims 5-8 is contained herein below.

Claims 1-4 rejected under 35 U.S.C. 112(1 & 2) and 102(b) have  
been overcome through applicant's amendment canceling said  
claims. Given that claims 1-4 are canceled, applicant's arguments  
regarding said claims are considered moot.

Newly added claims 5-8 are rejected under 35 U.S.C. 112(2) and  
102(b).

**Specification**

Objection to the abstract is maintained. The abstract should be  
in narrative form and generally limited to a single paragraph on  
a separate sheet within the range of 50 to 250 words. The  
abstract also appears to contain the misspelled word  
"homeopathis".

**Claim Objections**

Claims 5-8 are objected to under 37 CAR 1.75(c), as being of  
improper dependent form for failing to further limit the subject  
matter of a previous claim. Applicant is required to cancel the  
claim(s), or amend the claim(s) to place the claim(s) in proper  
dependent form, or rewrite the claim(s) in independent form.  
Claim 5 is drawn to a medicinal preparation comprising an active  
medicinal substance in therapeutic dose and a potentiated  
homeopathic medicinal substance having a same chemical formula or  
composition as said active medicinal substance. Claims 6 and 8  
are also drawn to a medicinal preparation comprising an active  
medicinal substance in therapeutic dose and a potentiated

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homeopathic medicinal substance. Neither claim 6 nor claim 8 set forth any subject matter which limits the composition set forth in claim 5.

5 **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

10 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15 Claims 5-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the absence of a structural formula or chemical name, the following terms are seen to render the claims in which they appear indefinite in all occurrences: medicinal substance and  
20 medicinal preparation.

In claims 5-8, applicant recites a medicinal preparation which is produced by homeopathic methods and has initial chemical formula or composition identical with that of the said active substance. It is unclear as to how a compound that has the  
25 "identical" chemical formula as the active substance can be differentiated from the active substance and is not the active substance itself as products of identical chemical composition can not have mutually exclusive properties.

30 **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5           Claims 5-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ecanow, U.S. Patent No. 4,963,367.

          Claims 5-8 are drawn to a medicinal preparation comprising an active medicinal substance in therapeutic dose and a potentiated homeopathic medicinal substance having a same  
10       chemical formula or composition as said active medicinal substance. The patentability in composition claims resides in the compound, no matter what method of production is set forth. A compound that has the "identical" chemical formula as the active substance can not be differentiated from the active  
15       substance. The open claim language also allows for the addition of common or suitable excipients or carriers. As such, applicant has made a claim to any compound of therapeutic nature. Ecanow anticipates these claims as it discloses a medicinal preparation comprising a material carrier and one or more active compounds  
20       dispersed in an aqueous solution (see claim 5 and p.1-3).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25           A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Ending

Any inquiry concerning this communication or earlier  
5 communications from the examiner should be directed to Howard Owens  
whose telephone number is (703) 306-4538 . The examiner can normally be  
reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful,  
the Primary Examiner signing this action, James O. Wilson can be reached  
10 on (703) 308-4624 . The fax phone number for this Group is (703) 308-  
4556.

Any inquiry of a general nature or relating to the status of this  
application or proceeding should be directed to the Group receptionist  
whose telephone number is (703) 308-1235.

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Howard Owens

Group 1623

*Howard C. Lee*

Howard C. Lee Primary Examiner Art Unit 1623
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